Remarks

Status of Claims

Claims 1-32 and 34 are pending in the application. All claims have been rejected. Claim 1 and Claim 23 are the two independent claims.

Claims 1-22 and 34 were objected to because of the following informalities: In the eleventh and last line of claim 1, "customers needs" should be "customer's needs" with an apostrophe.

Claim 1 has been amended as suggested by the Examiner to correct a typographical error and change "customers" to "customer's" in the eleventh and last line of Claim 1. It is submitted that this amendment overcomes the Examiner's objection to Claims 1-22 and 34.

Claim 13 and 14 were objected to as being in improper multiple dependent claim form.

Claims 13 and 14 have been amended to put them in proper multiple dependent claim form as illustrated in MPEP§608.01(n).

Summary of Invention

The subject matter of the present invention relates to a method of obtaining motor vehicle engine oil having characteristics desired by a user via using a wide area computer network to enable a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's specific needs.

Claim 1 as amended reads:

1. A method of obtaining motor vehicle engine oil having user desired characteristics by using a wide area computer network by:

(a) obtaining and inputting data from a user, including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements;

(b) analyzing the data by computer; and

(c) responsive to (b) providing a motor vehicle engine oil having recommended, or user desired enhancements;

wherein (a)-(c) are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs.

According to Claim 1 of the present invention, a wide area computer network site is provided which allows a customer, in one of several ways, to participate in the design, selection or customization of a particular motor oil to fit that customer's individual needs. (specification page 1, lines 14-16). More particularly, data is obtained from the user to identify the user's desired requirements for the motor oil to be obtained. This data may include information about the motor vehicle in which the engine oil is to be utilized as well as information relating to the environment of use, the operational characteristics desired by the customer, ambient temperature, the customer's average driving distance, the user's normal type of driving, and customer interest in fuel economy, cold weather starting, engine longevity and the ability to extend oil drain intervals. The data is analyzed by a computer and an oil is provided to the user which has the characteristics desired by the user.

Claim 23 provides a method of obtaining custom engine oil by: (a) using an implement to transmit information from a user about a user's motor vehicle type, environment of use, and desired operational characteristics, to a customized blending facility; (b) blending a custom engine oil using the information from (a); and (c) delivering to, installing or making available the custom engine oil.

The methods of both Claim 1 and Claim 23 permit a motor oil customer to participate in the design, selection or customization of motor oil which has characteristics desired by the motor oil user.

35 USC § 103 Rejections

Claim 1 and 2 were rejected under 35 USC 103(a) as being unpatentable over the anonymous article "Ford Issues Car Care Alert" ("Ford") in view of Osborn et al. (U. S. Patent 6,182,048).

The Examiner has the burden of establishing a prima facie case of obviousness. In order to establish obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. (see, MPEP 706.02(j)).

The Examiner has not established a prima facie case of obviousness because the prior art does not teach or suggest all of the claim limitations since 1) none of the references teach or suggest customizing motor oil for an individual consumer; 2) there is no suggestion or motivation to modify the Ford reference to analyze motor vehicle information by computer since Ford does not address customizing motor oil for an individual consumer; 3) a computer is not needed in Ford to analyze data in order to provide a motor oil selected on the basis of data input by an individual consumer.

The Ford article does not pertain to custom blended oil. Ford merely advises the use of a proper known oil available from any company. Ford merely provides a suggestion to motorists to use the proper engine oil and says that most manufacturers of vehicles specify 5w-30 oil but that vehicle owners should check their owner guides for specific recommendations; however, there is no suggestion in Ford of customizing an oil to impart characteristics desired by a particular user who had supplied data to provide the basis for designing a customized motor oil for that particular user. The 5w-30 oil suggested by Ford can be any previously manufactured 5w-30 motor oil available by walking into a store and picking it off a shelf. Even for vehicles for which 5w-30 oil might not be the preferred oil, there is no suggestion in Ford that the motor oil for those

vehicles is customer designed or that it is not a previously manufactured oil which can be purchased off the shelf at a store just as the 5w-30 oil can be.

Osborne is directed to a system and method for providing risk-based pricing for vehicle warranties. Osborne may collect data about the vehicle to be covered by the warranty but it is for the purpose of analyzing risk and not for providing a customized component for the car. Osborne is not directed to motor oils at all. Osborne may collect data but not for the purpose of allowing the consumer to design his own motor oil or his own warranty. Osborne does not provide the customer with any choices. The Osborne seller of warranties is gathering information in order to fix a profitable price which the seller will charge the customer for a warranty.

The Examiner relies on Osborne to argue that step (b) of Applicants' Claim 1 is obvious. As mentioned previously, Osborne is directed to a system and method for providing risk-based pricing for vehicle warranties. The Examiner relies on Osborne as evidence that data related to vehicles is collected and analyzed by computer. Osborne does not collect data for the purpose of allowing the consumer to design his own motor oil or even his own warranty. The invention must be considered as a whole and cannot be found obvious because the Examiner claims that individual steps, similar to those in the claimed invention, may be known. At the time the present invention was made, it was not known or obvious to obtain data from consumers to permit them to design a motor oil customized or enhanced to meet their individual needs.

Ford and Osborn together do not teach or suggest all limitations of Claims 1 and 2 as neither Ford nor Osborne suggests a method for permitting a consumer to participate in the design of a customized motor oil. A prima facie case of obviousness has not been made as a limitation in Claims 1 and 2 of the present invention is still missing – consumers' participation in the design of their motor oils based on the consumers' specific lubrication needs.

Claim 3 was rejected under 35 USC 103(a) as being unpatentable over "Ford" and Osborn as applied to claim 1 and further in view of Wilkinson ("Understanding What's in your Car's Motor Oil").

The Examiner takes the position that Wilkinson teaches that the advantages of a motor oil depend on ambient temperatures and that Osborn teaches computer analysis based on expected ambient temperatures and that it would have been obvious to input at least one of expected ambient temperatures, average driving distance, normal type of driving and interest in fuel economy, cold weather starting, and engine longevity, for the obvious advantage of providing an engine oil suited to a particular user's needs.

For the reasons stated previously Applicants submit that Ford and Osborn together do not teach or suggest all limitations of Claim 3 as neither Ford nor Osborne suggests a method for permitting a consumer to participate in the design of a customized motor oil to fit that consumer's needs.

Wilkinson merely describes some characteristics of known motor oils with regard to cold temperature performance. Wilkinson does not describe analyzing data input by a consumer or providing a customized motor oil based on such data and, as stated above, Osborne is not directed to motor oils at all. Osborne may collect data but not for the purpose of allowing the consumer to design their own motor oil or their own warranty.

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. Ford, Osborn and Wilkinson together do not teach or suggest all the Claim 3 limitations as nothing in them alone or in combination suggests a method for permitting a consumer to participate in the design of a customized motor oil. Therefore, no prima facie case for obviousness for Claim 3 has been made.

Claims 4, 5, and 6 were rejected under 35 USC 103(a) as being unpatentable over "Ford" and Osborne as applied to claim 1 and further in view of Klepacki ("Reflect to Mirror Users").

For the reasons stated previously Applicants submit that Ford and Osborn together do not teach or suggest all limitations of Claims 4, 5, and 6 as neither Ford nor Osborne suggests a method for permitting a consumer to participate in the design of a customized motor oil. Nor does Klepacki suggest a method for permitting a consumer to participate in the design of a customized motor oil to fit that consumer's particular needs.

Klepacki is directed to an e-commerce cosmetics site wherein cosmetics and hair care products can be made to order based on an individual's preferences. There is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized motor oil and there would be no motivation to combine Klepacki with Ford and Osborne in an attempt to reconstruct Applicant's claimed invention. Since there is no motivation to combine these references it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Applicant's specification as a blueprint in an attempt to reconstruct Applicants' invention from isolated pieces of the prior art.

The motivation for combining references must come from the prior art, not applicant's specification. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." In re Lee, 277 F.3d at 1343, citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). See In re Dow Chem. Co., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988) ("[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure"). Using an applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of § 103 which requires judging obviousness at the point in time when the invention was made. See Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. Ford, Osborn and Klepacki together do not teach or suggest all the limitations of Claims 4, 5, and 6 as nothing in them alone or in combination suggests a method for permitting a customer to participate in the design of a customized motor oil to fit that customer's needs. A prima facie case of obviousness has not been made as a limitation in Claims 4, 5 and 6 of the present invention is still missing – the consumers' participation in the design of a motor oil based on the consumer's specific lubrication needs.

Claim 7 was rejected under 35 USC 103(a) as being unpatentable over "Ford", Osborn, and Klepacki as applied to claim 6 and further in view of official notice. Official notice is taken that it is well known to display advertising indicia on computer screens.

The Examiner argues that it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicants' invention to display on the computer screen indicia indicating the ability of the user to order other automotive products, for the obvious advantage of profiting form the sale of automotive products to persons likely to be interested in buying them.

Ford does not describe analyzing data input by a consumer or providing a customized motor oil based on such data and, as stated previously, neither Klepacki nor Osborne is not directed to motor oils at all. Osborne may collect data but not for the purpose of allowing the consumer to design his own motor oil or his own warranty. Klepacki is directed to an e-commerce cosmetics site wherein cosmetics and hair care products can be made to order based on an individual's preferences. There is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized motor oil and there would be no motivation to combine Klepacki with Ford and Osborne in an attempt to reconstruct Applicant's claimed invention. Moreover, while it may be known to display advertising indicia on computer screens, it is not known or obvious to obtain data from consumers to permit them to design a motor oil customized to their individual needs. The invention must be considered as a whole and cannot be found obvious because individual steps may be known. Thus, Ford, Osborn,

and Klepacki, together with the Examiner's official notice do not teach or suggest all limitations of Claim 7 as none of them suggests a method for permitting a customer to participate in the design of a customized motor oil to fit that customer's needs, and, therefore, a prima facie case of obviousness has not been made.

Claims 8-12, 14, 15, 16, 21, and 22 were rejected under 35 USC 103(a) as being unpatentable over "Ford", Osborn, and Klepacki as applied to claim 4 and further in view of Denis.

There is some confusion about the references being cited in this rejection. In the second sentence, the Examiner says "As per claims 8-12, "Telco" is not explicit about the compositions of the lubes...."; however, in the first sentence, the Examiner did not recite Telco as being one of the references being applied to reject these claims, and the Examiner did not discuss how Ford is applied to any of Claims 8-12, 14, 15, 16, 21, and 22.

Applicants assume that Ford was the intended reference rather than Telco. With regard to Ford, it is Applicants' position that Ford does not pertain to custom blended oil but merely advises the use of a proper known oil available from any company. Ford does no more than provide a suggestion to motorists to use the proper engine oil and says that most manufacturers of vehicles specify 5w-30 oil but that vehicle owners should check their owner guides for specific recommendations. There is no suggestion in Ford of customizing an oil to impart characteristics desired by a particular user who had supplied data to provide the basis for designing a customized motor oil for that particular user.

Contrary to the Examiner's contention, Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils. The Examiner cites Denis to demonstrate that a variety of additives are known and are used to obtain different properties in a motor oil, but that is not relevant to an analysis of the claimed invention. The present invention is not claiming the composition of the motor oil, but the method of obtaining a customized motor oil to suit a particular consumer's needs. The consumer may not tailor the crankcase oil of Denis to suit his individual needs. Denis merely describes a fully

blended crankcase oil with a slate of additives. The present applicants are not claiming the composition of the motor oil but a method of obtaining a customized motor oil to suit a specific consumer's needs.

Osborne is directed to a system and method for providing risk-based pricing for vehicle warranties. Osborne may collect data about the vehicle to be covered by the warranty but it is for the purpose of analyzing risk and not for providing a customized component for the car.

Klepacki is directed to an e-commerce cosmetics site wherein cosmetics and hair care products can be made to order based on an individual's preferences. There is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized motor oil and there would be no motivation to combine Klepacki with Ford and Osborne in an attempt to reconstruct Applicant's claimed invention.

Thus, Ford, Osborn, Klepacki and Denis together do not teach or suggest all limitations of Claims 8-12 as none of them suggests a method for permitting a customer to participate in the design of a customized motor oil to fit that customer's needs. A prima facie case of obviousness has not been made as a limitation in Claims 8-12 of the present invention is still missing – the consumers' participation in the design of a motor oil based on the consumer's specific lubrication needs.

By "Telco" Applicants assume the Examiner meant the anonymous article "Telco, LML, Apollo Tyres Tie up with Castrol," which was cited in an earlier office action. If the Examiner did intend to cite Telco rather than Ford in this instance, it is Applicants position that Telco alone, or in combination with Osborn, Klepacki and Denis, does not render the present invention obvious. Telco appears to be a press release from India announcing an arrangement between Castrol India and two vehicle manufacturers for Castrol to supply two new lubes – Castrol GTX and GTD – for the automotive manufacturers' diesel cars and two-wheel vehicles. Although the press release uses the term "customized," these lubricant offerings are not customized in the manner taught and claimed by the

present application. "Customized" in the Telco reference means that the lubricants meet the needs of an entire line or class of vehicles, i.e., two-wheelers or diesels, not the needs of a particular consumer. Moreover, Telco does not disclose a method by which consumers can participate in the design of their motor oils. The lubricants in Telco were designed by Castrol, not the consumer. In the present invention the motor oil is customized by the consumer for the consumer's particular car and operating conditions of that car. This is clearly different from offering motor oils to original equipment manufacturers (OEMs) for a certain class or line of vehicles. Thus, Telco does not disclose a method for obtaining a "customized" engine oil as claimed by the present invention. Telco does not describe motor oil customized by the consumer using data input by the consumer to meet the consumer's particular requirements. Thus, Telco, Osborn, Klepacki and Denis together do not teach or suggest all limitations of Claims 8-12 as none of them suggests a method for permitting a customer to participate in the design of a customized motor oil to fit that customer's needs.

With regard to Claims 14, 15, 16, and 21 the Examiner argues that, regarding claim 14, Denis teaches in Example III providing a absolute increase of from about 0.1-10% in at least on selected from the group consisting of fuel economy additives, antiwear additives, detergent additives, dispersant additives, oxidation control additives, corrosion inhibitors, pour point depressants and blend stability additives and that it would have been obvious to practice step (c) of Applicants' claimed invention to add additives as listed for the advantages of producing increased fuel economy, reduced wear, etc. The Examiner advances similar arguments regarding Claim 15, saying that Denis teaches adding additives to motor oils to produce two or more enhanced features, regarding Claim 16, that Denis teaches adding additives leading to at least three of said enhanced features. Regarding Claim 21, the Examiner argues that while Denis does not expressly disclose that (c) is practiced do to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor

oil, Denis does teach that "a basic nitrogen containing dispersant" can vary from 1 to 15 weight percent and that "a detergent in the form of an overbased calcium sulfonate" from 0.2 to 3 weight percent and that it would have been obvious to practice Applicants' step (c) to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil to produce a customized engine oil having desired properties.

Applicants submit that the Examiner appears to have lost site of the claimed invention. The Examiner cites Denis to demonstrate that a variety of additives are known and are used in varying concentrations to obtain different properties in a motor oil; however, the fact that motor oils can contain additives which provide certain properties is not relevant to an analysis of the claimed invention. The present invention is not claiming the composition of the motor oil, but the method of obtaining a customized motor oil to suit a consumer's needs. The invention described and claimed in the present application is directed to a method of doing business. The Examiner's rejection seems to be directed to the patentability of the motor oil produced as a result of the business method. This is an incorrect analysis. The method permits the direct involvement of the consumer when designing a motor oil to suit that particular consumer's individual needs. This business method is not obvious.

Ford, Osborn, Klepacki and Denis together do not teach or suggest all limitations of Claims 14, 15, 16, and 21 as none of them suggests a method for permitting a consumer to participate in the design of a customized motor oil. For the reasons stated previously regarding the disclosure of Telco it would also be the case, if Telco was intended to be cited instead of Ford, that Telco, Osborn, Klepacki and Denis together do not teach or suggest all limitations of Claim 14, 15, 16, and 21 as none of them suggests a method for permitting a customer to participate in the design of a customized motor oil to fit that customer's needs. Thus, a prima facie case of obviousness has not been made as a limitation in Claims 14, 15, 16 and 21 of the present invention is still missing – the

consumers' participation in the design of a motor oil based on the consumer's specific lubrication needs.

Claim 13 was rejected under 35 USC 103(a) as being unpatentable over "Ford", Osborn, Klepacki and Denis as applied to claims 8-12 and further in view of official notice that the effects of many additives are, within a range, dependent on concentration. The Examiner admits that neither "Ford" nor Denis discloses that (c) is practiced to provide about 0.1 -100% improvement in at least one of fuel economy, wear performance, detergent performance, dispersant performance, oxidation protection corrosion protection, low temperature performance and blend stability, but that Denis teaches additives to improve these characteristics. The Examiner then takes official notice that the effects of many additives are, within a range, dependent on concentration, so that, even if the improvement were over 100% under some circumstances, a lower concentration would produce an improvement of less than 100% -- and indeed, it might be that no concentration of an additive would improve performance by more tan 100% over a baseline oil and argues that it would have been obvious to practice (c) to provide about 0.1-100% improvement in at least one of the listed characteristics as a consequence of adding desirable additives as taught by Denis.

With regard to the Examiner's taking of official notice that the effects of many additives are, within a range, dependent on concentration, Applicants do not agree that the Examiner's statements of "common knowledge" or "well-known in the art" are in fact prior art. The Examiner relies heavily and improperly on official notice of "common knowledge" or "well-known prior art" to fill the gaps in his argument in an attempt to create a prima facie case of obviousness; however, the Examiner does not provide evidentiary support for such arguments. The articles recited by the Examiner to support the official notice that that the effects of many additives are, within a range, dependent on concentration do not even relate to additives to engine oil. Marti relates to the use of phyto-additive ingredients, which are herbal and plant extracts, in cosmetics. Zambiazi does

not even relate to additives but describes the role of endogenous lipid components on vegetable oil stability. Lustig relates to a building material additive comprising a dispersion of a hydro-phobic substance completely wetted by a surfactant, and a water-soluble polymer, and Kay relates to an accelerator used to increase the vulcanization rate of rubber. None of these support the Examiner's contention that the effects of many additives are, within a range, dependent on concentration in relation to the subject matter of the present invention.

For the reasons stated previously, Applicants again submit that the Examiner is losing sight of Applicants' claimed invention, which is not directed to a particular motor oil composition or to particular additives added to enhance properties of motor oil, but to a method which enables a customer to participate in the design of a motor oil which will meet that particular customer's specifications and needs. The invention must be considered as a whole and cannot be found obvious because individual steps may be known. Ford, Osborn, Klepacki, Denis, and the Examiner's official notice (which is not supported by the cited documentation) together do not teach or suggest all limitations of Claim 13 as none of them suggests a method for permitting a customer to participate in the design of a customized motor oil to fit that customer's needs, and, therefore, a prima facie case of obviousness has not been made.

Claims 17, 18, 19, and 20 were rejected under 35 USC 103(a) as being unpatentable over "Ford", Osborn, Klepacki and Denis as applied to claims 15 in the case of claims 17 and 19 and to claim 16 in the case of claims 18 and 20 and further in view of official notice.

As discussed previously Ford does not pertain to custom blended oil, but merely advises the use of a proper known oil available off the shelf.

Osborne is not directed to motor oils at all but to a system and method for providing risk-based pricing for vehicle warranties and any data collected about a vehicle is for the purpose of analyzing risk and not for the purpose of allowing a consumer to design his own motor oil or his own warranty.

Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils, and while Dennis may show that additives are known and are used to obtain different properties in a motor oil, that is not relevant to an analysis of the claimed invention, which is a not a motor oil but a method for permitting a consumer to participate in the design of a customized motor oil.

Klepacki is directed to an e-commerce cosmetics site wherein cosmetics and hair care products can be made to order based on an individual's preferences. There is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized motor oil and there would be no motivation to combine Klepacki with Ford and Osborne in an attempt to reconstruct Applicant's claimed invention without using hindsight, which is clearly impermissible.

The official notice taken with regard to Claims 17, 18, 19, and 20 is the same as that applied for Claim 13, that the effects of many additives are, within a range,. dependent on concentration, and, for the reasons given previously, Applicants submit that this is not supported by the references cited by the Examiner.

Again Applicants submit that their invention is not a motor oil composition, but a business method for enabling a consumer to participate in the design of a motor oil customized to meet his desired characteristics.

Since there is no motivation to combine "Ford", Osborn, Klepacki and Denis as well as the official notice that the effects of many additives are dependent on concentration, it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Applicant's specification as a blueprint in an attempt to reconstruct Applicants' invention from isolated pieces of the prior art. It is well established that such use of hindsight is impermissible.

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. Thus, Ford, Osborn, Klepacki and Denis together with the alleged official notice do not teach or suggest all

limitations of Claims 17, 18, 19, and 20 as none of them, either alone or in combination, suggests a method for permitting a customer to participate in the design of a customized motor oil to fit that customer's needs. Therefore, a prima facie case of obviousness has not been made as a limitation in Claims 17, 18, 19, and 20 of the present invention is still missing – the consumers' participation in the design of a motor oil based on the consumer's specific lubrication needs.

Claim 34 was rejected under 35 USC 103(a) as being unpatentable over "Ford" and Osborn as applied to claim 1 and further in view of the disclosure in the present application at page 2, lines 13-24 that there are accepted industry standard practices outlined in codes introduced by industry organizations such a the American chemistry council and the Technical Committee of Petroleum Additive Manufacturers in Europe.

The Examiner argues that it would have been obvious to practice (a) –(c) using formulation guidelines or computer models to maintain industry performance credentials of the customized engine oil.

Applicants respectfully traverse this rejection. As pointed out above, the invention must be considered as a whole and cannot be found obvious because individual steps may be known. Thus, Ford and Osborn together with the disclosure in the present application that accepted industry standards exist do not teach or suggest all the limitations of Claim 34. since nothing in them alone or in combination suggests a method for permitting a consumer to participate in the design of a customized motor oil to fit that particular consumer's needs. Therefore, a prima facie case of obviousness has not been made

Claims 23, 24, 25, and 26 were rejected under 35 USC 103(a) as being unpatentable over Klepacki in view of Wilkinson, the anonymous article "Drive Green Tips" and official notice.

As stated previously, Klepacki does not relate to motor oils at all but to cosmetics and hair care products. Klepacki is directed to an e-commerce cosmetics site wherein cosmetics and hair care products can be made to order based on an individual's preferences.

Wilkinson merely describes some characteristics of known motor oils with regard to cold temperature performance. Wilkinson does not describe analyzing data input by a consumer or providing a customized motor oil based on such data and, the anonymous article "Drive Green Tips" merely advises vehicle owners to use the oil, for example a 5w-30 oil, recommended in their owner's guide, which could be any previously mass produced motor oil available off the shelf in a store. Neither Wilkinson nor "Drive Green Tips" suggests a method of obtaining a custom engine oil which permits a consumer to participate in the design of a customized motor oil having operational characteristics desired by that consumer. Nor does Klepacki, which does not even relate to engine oils, suggest a method of obtaining a custom engine oil which permits a consumer to participate in the design of a customized engine oil to fit that consumer's particular needs.

The Examiner notes that Klepacki does not expressly disclose delivering to, installing, or making available for pickup by a use a custom product, but takes official notice that it is well known for e-commerce websites to deliver or make available products ordered by users. Even if that were the case, The invention must be considered as a whole and cannot be found obvious because individual steps may be known.

Furthermore, the Examiner does not provide any evidence to support the taking of official notice that it is well known for e-commerce websites to deliver or make available products ordered by users, and Applicants do not admit that the Examiner's statement is prior art.. The Examiner cannot simply reach conclusions based on his own understanding or experience or on his assessment of what would be basic knowledge or common sense. Deficiencies of references cannot be saved by appeals to "common sense" and "basic knowledge" without any evidentiary support. See In re Zurko, 258 F.3d 1379, 59 U.S.P.Q. 2d 1693 (Fed. Cir. 2001). If the information relied upon by the Examiner is in fact common knowledge then the Examiner should provide evidentiary support for such arguments.

There is no suggestion in Klepacki of permitting a consumer to participate in the design of a customized engine oil and there would be no motivation to combine Klepacki, which does not relate to engine oils, with Wilkinson and "Drive Green Tips" in an attempt to reconstruct Applicant's claimed invention. Since there is no motivation to combine these references it is submitted that the Examiner is clearly using hindsight to hunt and peck among various references using Applicant's specification as a blueprint in an attempt to reconstruct Applicants' invention from isolated pieces of the prior art which is impermissible.

Thus, Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest all the limitations of Claim 23 since nothing in them alone or in combination suggests a method of obtaining custom engine oil which permits a consumer to participate in the design of a customized engine oil to fit that particular consumer's needs. Therefore, a prima facie case of obviousness has not been made

With regard to the rejection of Claims 24, 25, and 26, Applicants again point out that the invention must be considered as a whole and cannot be found obvious because individual steps may be known. Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest all the limitations of Claims 24, 25, and 26 since nothing in them alone or in combination suggests a method of obtaining custom engine oil which permits a consumer to participate in the design of a customized engine oil to fit that particular consumer's needs. Therefore, a prima facie case of obviousness has not been made.

Claims 27-32 were rejected under 35 USC 103(a) as being unpatentable over Klepacki in view of Wilkinson, "Drive Green Tips" and official notice applied to Claim 23 above and further in view of Denis et al. (U.S. Patent 4,954,273).

As discussed previously, the Examiner provides no evidentiary support for the taking of official notice that it is well known for e-commerce websites to deliver or make available products ordered by users.

The Examiner admits that neither Klepacki nor Wilkinson discloses that blending a custom engine oils is practiced to add additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability, but argues that Denis teaches adding additives to enhance two or more of these features in Fully Formed Example III and that it would have been obvious to practice (b) to add additives leading to at least two or more of the listed enhanced features.

Denis does not teach a "customized motor oil," but an over-based salt additive for crankcase oils. The Examiner cites Denis to demonstrate that a variety of additives are known and are used to obtain different properties in a motor oil, but that is not relevant to an analysis of the claimed invention. The present invention is not claiming the composition of the motor oil, but the method of obtaining a customized motor oil to suit a particular consumer's needs. The consumer may not tailor the crankcase oil of Denis to suit his individual needs. Denis merely describes a fully blended crankcase oil with a slate of additives. Nothing in Denis suggests a method of obtaining a customized motor oil to suit a specific consumer's needs.

The invention must be considered as a whole and cannot be found obvious because individual steps may be known. For the reasons stated previously in responding to the rejection of Claims 23-26, Klepacki, Wilkinson, the anonymous article "Drive Green Tips" together with the Examiner's official notice that e-commerce websites deliver or make available products ordered by users do not teach or suggest all the limitations of Claims 27-32. Nothing in them alone or in combination with Denis suggests a method of obtaining custom

engine oil which permits a consumer to participate in the design of a customized engine oil to fit that particular consumer's needs. Therefore, a prima facie case of obviousness has not been made.

In conclusion, the Examiner failed to establish a prima facie case of obviousness because the references do not teach or suggest all of the claim limitations. When the claimed invention is considered as a whole, it is not obvious in view of the references combined and applied by the Examiner.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance.

Reconsideration, allowance of all claims, and passage of the application to issue are respectfully requested.

If the Examiner believes an oral or telephonic interview would advance the prosecution of this case, the Examiner is encouraged to contact Applicants' attorney at the Examiner's convenience.

Respectfully submitted,

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